

REMARKS

Claims 1 to 11 were rejected under 35 U.S.C. §112, first paragraph, because the specification.

The Office Action admits the specification is enabling for a UV-hardenable clear lacquer, namely UVHC 8558. The Office Action asserts that the specification does not reasonably provide for any other types of UV curable clear lacquers.

It is noted that in paragraph [0042] of the specification refers to a UV hardener. The use of UVHC 8558 is merely given as an example in paragraph [0044].

The disclosure and example clearly enable one of skill in the art to make a coating composition with a UV-hardenable clear lacquer as claimed, especially since a very clear example for one of skill in the art for such a coating using UVHC 8558 is given.

See MPEP 2164.01(b), the following which is a quotation therefrom:

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112. Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.), cert. denied, 484 U.S. 954 (1987).

MPEP 2164.01(b).

As admitted, the specification shows one enabling coating composition wherein one of the components is a "UV-hardenable clear lacquer" as claimed.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph thus is hereby respectfully requested.

Claim 9 has been canceled.

CONCLUSION

The present application is respectfully submitted as being in condition for allowance and applicants respectfully request such action.

Respectfully submitted,

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